

REMARKS

Claims 1-2, 4-22 and 24-43 are pending in the present application. Claims 1, 18, 21 and 35 are independent claims.

Initialed PTO-1449 Needed

Applicants filed an IDS on August 28, 2006. The Examiner is respectfully requested to return the initialed PTO-1449 form associated with it. This was requested in the last Reply, but Applicants still have not received it.

35 U.S.C. § 103 Rejection

Claims 1, 2, 4, 8-22, 24-25 and 30-42 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. in view of Motamed et al. and further in view of DeHority. Claim 43 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. in view of Motamed et al. and DeHority, as applied to claim 1 above, and further in view of Beck. Claims 5-7 and 26-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leiman et al. in view of Motamed et al. and DeHority, as applied to claim 1 above, and further in view of Applicants' disclosed related art. These rejections are respectfully traversed.

Firstly, the newly found document US '969 (Motamed et al.) claims priority to U.S. provisional application no. 60/160,414 filed Oct. 19, 1999, consisting of two software specifications of the Fiery Lobos version 1.4 and version 1.5 marked "EFI Confidential." Although Applicants have not compared the provisional application with the Motamed patent, Applicants respectfully submit that that due to the priority claim of Applicants' application, any matter which has been added after the filing of the provisional application in Motamed et al. should have an effective U.S. filing date, which is later than Applicants' priority date. If needed, Applicants are willing to file a certified English translation of Applicants' foreign priority document to perfect the priority claim.

Secondly, independent claim 1 recites, *inter alia*, “selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device” (emphasis added). Other independent claims 18, 21 and 35 recite similar feature sin a varying scope.

The Examiner states in the final Office Action that the combination of the teachings of Leiman, in view of the newly found document Motamed and in view of DeHority render the claimed invention obvious. Applicants respectfully and completely disagree, in particular because there is absolutely no incentive or motivation to combine these teachings as suggested by the Examiner.

Leiman and Motamed teach a method and system in which a user sends a print job, having certain print job settings, to a plurality of printers. Particularly, Leiman selects the devices that are suitable for carrying out the requested print job from the plurality of available devices in the network. Leiman even disables or blocks the unsuitable devices, excluding these unsuitable devices from the list of selectable devices.

Motamed even teaches away from the presently claimed invention as Motamed clearly describes its behavior in case of unsuitabilities/errors, e.g., in the cited col 3, lines 35-37. The Motamed system is set for “automatic rerouting of a print job to another printer if the first selected printer is unable to perform the print job”. Clearly, there is no teaching or suggestion in Motamed that this ‘another printer’ is “the processing device not suitable for the job”, which becomes “selectable to become the selected processing device” as recited in claim 1. In this regard, the Examiner seems to agree with Applicants since the Examiner states “Motamed teaches “if a processing device among the processing devices belonging to the set is not suitable for performing the job, selecting a processing device our of all processing device belonging to the set”” (see paragraph 4 in the final Office Action). That is, it appears the Examiner has intentionally left out the rest of the claimed phrase “wherein the processing device not suitable for the job is selectable to become the selected processing device” as recited in claim 1 in association with the teachings of Motamed.

Therefore, even if the teachings of Leiman and Motamed were combined, assuming *arguendo*, the Leiman-Motamed system would present a group of printers to a user, wherein the unsuitable printers are blocked and the print job is rerouted to a printer which can perfectly execute the job. Thus, the teachings of Leiman and Motamed in general would result in a system that searches for a device that is able to print the job exactly as required.

In this regard, Applicants respectfully and strongly disagree with the statement of the Examiner, as posed in paragraph 5 of the final Office Action. A modification of the Leiman-Motamed system to make a processing device out of all processing devices belonging to the set, wherein a processing device not suitable for the job is selectable to become the selected processing device as claimed is clearly not obvious. The Leiman-Motamed system even blocks unsuitable devices and reroutes a job to another processing device. Even if the skilled person would combine Leiman and Motamed, he would arrive at a completely different system compared to Applicants' claimed invention.

DeHority discloses a method and system that presents a print job, having certain print job settings, to one single printer, whether or not the printer is suitable for executing this print job. The method in DeHority checks the suitability of this particular job with respect to the actual capabilities of the device and, depending on the configured strategy, presents the user with a choice to modify the print job settings manually, to modify the settings automatically based on a database of possible alternatives, or to cancel the job. A disadvantage of such system is that, in case the device is not suitable for the job, no print is delivered. Thus, the job is adapted to suit the job to the device capabilities.

As mentioned above, the Leiman-Motamed system (assuming *arguendo*) would be a system that teaches to always make sure that a job is printed on a printer which is perfectly suitable for the job on hand. Leiman and Motamed teach to block unsuitable printers and reroute the job to a suitable printer. Therefore, one person skilled in the art would NOT search for and/or use a document that teaches how to print a job on an unsuitable blocked device nonetheless, thereby possibly degrading the perfect execution of the job. Furthermore, the

teaching of DeHority in general is to adapt a job and/or the requirements of such a job to the capabilities of a device which is not suitable for the job *ab initio*. Therefore there is absolutely no incentive or motivation to combine Leiman, Motamed and DeHority as suggested by the Examiner.

Therefore, the combination of references as applied by the Examiner fails to teach or suggest, *inter alia*, "selecting a processing device out of all processing devices belonging to the set, wherein the processing device not suitable for the job is selectable to become the selected processing device" as recited independent claim 1. Other independent claims 18, 21 and 35 recite similar features in a varying scope.

Accordingly, independent claims 1, 18, 21 and 35 and their dependent claims are allowable over the applied references, and the rejections are improper and should be withdrawn.

Conclusion

In view of the above remarks, it is believed that claims are allowable and an issuance of the Notice of Allowance is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong, Reg. No. 40,953 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

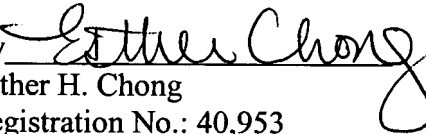
Application No. 09/878,962
Reply dated October 19, 2007
After Final Office Action of June 19, 2007

Docket No.: 0142-0355P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 19, 2007

Respectfully submitted,

By 
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